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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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09/868,254

06/15/2001

Hugh Boyd Morrison

RCA 89185

6997

7590 10/31/2008
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EXAMINER

BROWN, RUEBEN M

ART UNIT

PAPER NUMBER

2424

MAIL DATE

DELIVERY MODE

10/31/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|----------------------------------------|--|
| Office Action Summary | Application No. 09/868,254 | Applicant(s) MORRISON ET AL. | |
| | Examiner REUBEN M. BROWN | Art Unit 2424 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 8, 9, 11 and 13 is/are rejected.
- 7) ☒ Claim(s) 5, 7, 10, 12 & 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 6, 8-9, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boyer, (U.S. PG-PUB 2005/0138660), in view of Hussmann, (U.S. Pat # 6,101,535).

Considering claims 1 & 11, the amended claimed method for operating a video processing apparatus, such that the '*video processing apparatus operates in a video-operating mode and in a computer mode, and wherein the video processing apparatus has an EPG operable in the video operating mode and not in the computer mode*', is met by the disclosure of Boyer, (Fig. 2), which shows the standard operating mode of an EPG.

'Operating the video processing apparatus in the computer mode, comprising by running a computer application software program on the video processing apparatus, such that the computer application software program is capable of receiving messages' is met by the disclosure of Boyer, that the user equipment, multimedia system 28, 3, 32 is enabled to support e-mail technology, (Fig. 1; Para [0042]-[0043]). The claimed computer application software program, reads on the e-mail service disclosed in Boyer. The amended claimed feature of the computer application software program having a display, reads on the display of Fig. 6.

'causing an advertisement associated with a broadcast TV program, while the computer application software program is running' is met by Fig. 6; Para [0051]-[0052], which shows an advertisement for a TV program being received via e-mail.

'receiving a signal indicating a user selection of the advertisement while the computer application is running', reads on the user in Boyer, selecting the e-mail reminder.

and *'providing a user selection display in response to the user selection of the advertisement, such that the user selection display comprises a listing of a plurality of user selectable options associated with the instant broadcast TV program'*, Boyer does not specifically show that the subscriber can select the advertised program, for tuning, from the reminder. Nevertheless Hussmann, which is in the same field of endeavor, teaches a user receiving & selecting a ticket (which represents a movie or broadcast); col. 3, lines 32-45 & col. 4, lines 15-35. Once the selects a particular ticket for a movie the user has a plurality of options

associated with the ticket, such as presentation; see col. 4, lines 34-51; col. 5, lines 35-41. Since It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Boyer in order to automatically allow the user to access the program that is the subject of the advertisement, at least for the known benefits of interactive programming.

As for the further claimed feature that the selection display is provided while the computer software program is in running, and at least causes the apparatus to switch from computer mode to video mode', Hussmann teaches that the tickets are received via the browser on the PC, (col. 4, lines 51-67) which reads on the computer mode, and that once selected for displayed the movie may be displayed on the TV, via STB which reads on the video mode, see col. 2, lines 36-42.

Considering claims 2 & 8-9 & 13, the e-mail technology of Boyer meets the claimed subject matter.

Considering claim 3-4, the claimed '*control information*' reads on the disclosure of Hussmann that the system at least allows the user to order the program.

Considering claim 6 the claimed method steps for operating a video processing apparatus comprising steps that correspond with subject matter mentioned above on the rejection of claim 1, are likewise treated.

Allowable Subject Matter

4. Claims 5, 7, 10, 12 & 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A) Philyaw Receives advertisements of programming via an Internet connection.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

or faxed to:

(571) 273-8300, (for formal communications intended for entry)

Or:

(571) 273-7290 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Reuben M. Brown whose telephone number is (571) 272-7290. The examiner can normally be reached on M-F(8:30-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on (571) 272-7331. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300 for regular communications and After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Annan Q Shang/
Primary Examiner, Art Unit 2424